UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
BASEHOAR, ADAM L

ART UNIT	PAPER NUMBER
2178	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

epatent@usiplaw.com

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 June 2009</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24</u> is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-24</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date <u>07/09/09</u>.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: The Request for Continued Examination

(RCE) filed 06/02/09.

2.   All previous rejections to the claims have been withdrawn as necessitated by

Amendment.

3.   Claims 1-24 pending. Claims 1, 9, and 17 are independent.

Information Disclosure Statement

4.   The information disclosure statement (IDS) submitted on 07/09/09 has been considered

by the examiner.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 1-2, 7-8, 9-10, 15-18, 23 and 24, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Norris (US-6,147,768 11/14/00) in view of Farrell (US-5,383,129 01/17/95).

        -In regard to substantially similar independent claims 1, 9, and 17, Norris teaches a

computer-implemented method, medium, and system for determining the cost of and producing a

user-defined content object comprising:

defining said content object ("photographic album") in accordance with user selection

and arrangement (Fig. 3: "mats") of a plurality of content entities ("photographic image") for

said content object ("photographic album")(column 4, lines 53-67; column 5, lines 1-24; column

7, lines 49-67; column 8, lines 1-67; column 9, lines 1-13)(Figs. 2 & 3), wherein the content

object is a digital object within the computer in the form of one of a book, a collection of images,

an album, a video and a multimedia object (i.e. the photographic album is a collection of

images), and the content entities each include content comprising digital data ("video images" &

"size of the selected image"), are stored within a data repository as a plurality of individually

accessible file objects (column 7, lines 65-67; column 8, lines 1-24)(Fig. 2), and are selectively

associated with an actual content count representing the quantity of content within that content

entity (column 7, lines 65-67; column 8, lines 1-40: "number of each size print is counted"); and

generating a price for the user to produce the user-defined content object, wherein said

price is one of an actual price based on a parameter setting (column 5, lines 16-22: "price

database...prices for various sized pictures and various mats"; column 6, lines 12-22: "calculate a

customer invoice...picture sizes selected...their selected page locations"; column 8, lines 35-40:

"the number of each size print is counted and then multiplied out by the price per unit"; column

9, lines 10-14; column 10, lines 4-17: "price is generally determined by the number and size of

the selected images"), wherein the quantity of content of content within the content object could

be determined via the digital data within the selected content entities (column 6, lines 12-22:

"calculate a customer invoice...picture sizes selected...their selected page locations"; column 8,

lines 35-40: "the number of each size print is counted and then multiplied out by the price per

unit"; column 9, lines 10-14; column 10, lines 4-17: "price is generally determined by the

number and size of the selected images") and said price generation includes and generating the

actual price to serve as the price for the user to produce the user- defined content object from the

actual content counts of the selected content entities in response to said parameter setting

indicating the actual price (column 5, lines 16-22: "price database...prices for various sized

pictures and various mats"; column 6, lines 12-22: "calculate a customer invoice...picture sizes

selected...their selected page locations"; column 8, lines 35-40: "the number of each size print is

counted and then multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-

17: "price is generally determined by the number and size of the selected images").

Norris teaches wherein printing photographic albums can be costly and a general

motivation for decreasing the expense of printing electronic photo albums (column 1, lines 37-

54: "costly...adding expense to the project...eliminating the cost"). Norris does not specifically

teach generating an estimated content count for the selected content entities that represents an

estimated quantity of content within the content object, wherein the digital data within the

selected content entities are utilized to determine the estimated content count representing the

estimated quantity of content within the content object, and generating from the estimated

content count the estimated price to serve as the price for the user to produce the user defined

content object with the selected content entities in response to said parameter setting indicating

the estimated price. Farrell teaches that based on a parameter setting (Fig. 10: 508) for either an

estimated price (Fig. 10: 510) or an actual price (Fig. 10: 512), determining a price (Fig. 11: 522:

"determine total PM cost for job") for the content object to be produced (Abstract: "cost of

printing materials used to print a job") based upon selecting the estimated price generating an

estimated content count that represents an estimated quantity of content within the content

object, wherein the digital data within the selected content entities are utilized to determine the

estimated content count (column 7, lines 46-67; column 8, lines 1-50: "counter established for

each unique printing materials type to be used in the print job...production of output usable to

the customer...assumed that the expected number of sets will be produced and an estimate is

produced...unit cost of each printing material type...stored in a database...look-up

table...expressed as a multiple reference value")(Figs. 10 & 11: 510: "For each PM item count

the expected quantity required to produce the expected number of sets", 518, 520, 522). It would

have been obvious to one of ordinary skill in the art the time of the invention for the system of

Norris to have included the estimated content count/price feature of Farrell, because Farrell

taught that by determining an estimated content count and subsequent estimated price of a

specific content entity the user would be provided the benefit of making an informed decision

about the cost of said entity, especially when the user had limited resources and the

materials/cost to create the content entity were relatively great (column 9, lines 29-37: "such

estimate is particularly useful"; column 8, lines 10-37: i.e. user can get a price estimate

before/without actually having to produce the content entity).

      -In regard to substantially similar independent claims 2, 10, and 18, Norris teaches

wherein the step of generating an estimated content count further comprises the steps of

determining an estimated content count for each selected content entity, and summing the entity

content counts to obtain the estimated content count for the content object (column 8, lines 35-

40: "the number of each size print is counted and then multiplied out by the price per unit";

column 9, lines 10-14; column 10, lines 4-17: "price is generally determined by the number and

size of the selected images"). Additionally, for similar benefits as disclosed above, Farrell also

teaches determining an estimated content count for each selected content entity and summing the

entity content counts to obtain the estimated content count for the content object (Fig. 10: 510;

Fig. 11: 518, 519, 520, 522, 523).

-In regard to substantially similar independent claims 7, 15, and 23, Norris teaches

wherein the content object further comprises user-provided content, and wherein generating a

price for the content object further comprises the steps of separately determining a price for user-

provided content and generating the selected estimated or actual price by summing the user-

provided content price with the price determined for the remaining selected content entities of

the content object (column 3, lines 25-58: "capturing video images to be entered into a

database"; column 5, lines 22-45; column 5, lines 16-22: "price database...prices for various

sized pictures and various mats"; column 6, lines 12-22: "calculate a customer invoice...picture

sizes selected...their selected page locations"; column 8, lines 1-40: "notes associated with the

displayed photographs can be added...the number of each size print is counted and then

multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-17: "price is

generally determined by the number and size of the selected images").

-In regard to substantially similar independent claims 8, 16, and 24, Norris teaches

wherein the price for user-provided content is determined in a first manner if the content count of

the user- provided content exceeds a predefined content count maximum, and is determined in a

second manner if the content count does not exceed the predefined maximum (column 4, lines

64-67; column 5, lines 1-22: "price database...prices for various sized pictures and various mats";

column 6, lines 12-22: "calculate a customer invoice...picture sizes selected...their selected page

locations" & 63-67: "automatically sizes each image to accommodate all sizes which are

necessary for use with a particular mat manufacture selected"; column 8, lines 1-40: "notes

associated with the displayed photographs can be added...the number of each size print is

counted and then multiplied out by the price per unit"; column 9, lines 10-14; column 10, lines 4-

17: "price is generally determined by the number and size of the selected images")(Fig. 3).

7.   Claims 3-6, 11-14, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Norris (US-6,147,768 11/14/00) in view of Farrell (US-5,383,129 01/17/95) in view of

Dedrick (US-5,768,521 6/16/98).

       -In regard to substantially similar independent claims 3, 11, and 19, Norris teaches

wherein the selected content entities could contain text characters (column 8, lines 1-24:

"notes"). Norris does not specifically teach determining an estimated content count for entities

containing characters comprises the step of determining a character count for the entity. Dedrick

teaches a method of metering the flow of electronic information to a client computer (Abstract).

Dedrick teaches determining a unit of information count for the content entity (a digital

entry)(column 1, line 62 – column 2 line 22; column 3 lines 60-63; column 4 line 26 – column 5

line 25; and column 7 lines 29-43). Dedrick specifically teaches estimating a content count for

each content entity may be calculated in bytes or words in (column 4, lines 63-64; column 5,

lines 10-25). It would have been obvious to one of ordinary skill in the art at the time of the

invention to applying the per byte/word character count of Dedrick to the calculation and

counting system of Norris, because Norris would have been provided the benefit of applying

metering to virtual objects such as online books, digital directories etc (column 4, lines 65-67:

"desirable when the end user is accessing a database that contains...drawings and text"; column

5, lines 1-2).

      -In regard to substantially similar independent claims 4, 12, and 20, Norris teaches

wherein the step of determining an estimated content count further comprises the step of

determining a page count from the character count (column 8, lines 1-53: "Pages 116...all

changes are reflected in the next invoice generated"). Additionally, for similar benefits as

disclosed above, Dedrick teaches specific examples that the content count unit may be in bytes or

words in (column 4, lines 63-64; column 5, lines 10-25). Determining a page count from the

character count is merely changing the units of the count from characters to pages. Dedrick

teaches an information unit count of bytes in column 4, lines 63-64 and megabytes in column 5,

lines 21-23. The two example units of Dedrick are related exactly as the characters and pages of

the claimed invention. Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to have applied Dedrick to Norris, providing Norris the benefit

of converting characters/images into pages so that the cost computation would have been

simplified.

      -In regard to substantially similar independent claims 5, 13, and 21, Norris does not

specifically teach wherein the step of determining a character count further comprises at least

one of: counting the number of content characters in the content entity and determining the

content entity type, and determining an average character count for content entities of that type.

Dedrick teaches determining a unit of information count for a content entity based on counting

the number of content characters in the content entity (column 4, lines 63-64; column 5, lines 10-

25). It would have been obvious to one of ordinary skill in the art at the time of the invention to

counting the number of the per byte/word character count of Dedrick to the calculation and

counting system of Norris, because Norris would have been provided the benefit of applying

metering to virtual objects such as online books, digital directories etc (column 4, lines 65-67:

"desirable when the end user is accessing a database that contains…drawings and text"; column

5, lines 1-2).

   -In regard to substantially similar independent claims 6, 14, and 22, Norris teaches

wherein the step of generating a content object price further comprises multiplying the page

count with a predetermined price per page value (column 8, lines 1-53: "Pages 116...all changes

are reflected in the next invoice generated…multiplied out by the price per print").

Response to Arguments

8.   Applicant's arguments with respect to claims 1, 9, and 17 have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Please note the additionally cited references on the accompanying PTO-892 Form.

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM L. BASEHOAR whose telephone number is (571)272-4121. The examiner can normally be reached on M-F: 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Adam L Basehoar/
Primary Examiner, Art Unit 2178